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|-----------------------------|-------------------------|----------------------------------|-----------------------------------|
| SERIAL NUMBER<br>077379,269 | FILING DATE<br>09/05/90 | FIRST NAMED INVENTOR<br>PANICALI | ATTORNEY DOCKET NO.<br>D ABT87-01 |
|-----------------------------|-------------------------|----------------------------------|-----------------------------------|

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EXAMINER  
ZITOMER, S

|                 |                    |
|-----------------|--------------------|
| ART UNIT<br>187 | PAPER NUMBER<br>18 |
|-----------------|--------------------|

DATE MAILED: 10/01/91

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined. ☐ Responsive to communication filed on \_\_\_\_\_. ☐ This action is made final.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.                 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-35 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1-35 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_, filed on \_\_\_\_\_.
13. ☒ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☒ Other

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EXAMINER'S

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-14 and 27-31, drawn to a recombinant pox virus and vectors therefor, classified in Class 435, subclasses 252.3 and 320.1;

II. Claims 15-24, drawn to methods for producing therapeutic pox virus antigens and antibodies, classified in Class 514, subclass 44;

III. Claim 25, drawn to a method for producing a monoclonal antibody, classified in Class 435, subclass 70.2;

IV. Claim 26, drawn to a method for therapeutic administration of antibody, classified in Class 514, subclass 21.

Invention I is related to Inventions II and III as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the processes for using can be practiced with a natural pox virus.

Inventions II and III are unrelated to Invention IV and are distinct as different processes wherein the products of II and III may be used in IV and the process of Invention IV can be

practiced with different products such as antibodies to naturally occurring pox virus.

Inventions I and IV are unrelated as being drawn to DNA and to a process using protein, respectively, wherein DNA and protein are chemically distinct compounds and the protein can be used in a different way, for example, as a tissue-specific carrier for a therapeutic compound.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie Zitomer whose telephone number is (703) 308-3881. Any inquiry of a general nature or relating to the status of this application

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should be directed to the Group 180 receptionist at (703) 308-0196.

*SUZ*

Stephanie W. Zitomer, Ph.D.  
September 30, 1991

*Robert A. Wax*

ROBERT A. WAX  
SUPERVISORY PATENT EXAMINER  
ART UNIT 187